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22850 7590 04/27/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER BAYAT, BRADLEY B	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/926,686
Filing Date: December 03, 2001
Appellant(s): HUBER ET AL.

MAILED

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GROUP 3600

Raymond F. Cardillo, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 15, 2006 appealing from the Office action mailed April 7, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

6,226,618 B1

DOWNS ET AL.

05-2001

Zhao et al., "Bandwidth-Efficient Continuous Media Streaming Through Optimal Multiplexing"

Sigmetrics publication of May 1999, pp. 13-22.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downs et al. (hereinafter Downs), U.S. Patent 6,226,618 B1 in view of publication by Zhao and Tripathi (hereinafter Zhao), titled *Bandwidth-Efficient Continuous Media Streaming Through Optimal Multiplexing*, pp.13-22, published May 1999.

As per claim 1, Downs discloses a method for ordering and transmitting of digital objects comprising: transmitting an object order for digital media objects that comprises at least one object identification (figure 1b, 1d, 2 and associated text), transmitting data on a time at which an ordered media object is available by the center to any communications terminal, wherein the time is determined by the center and is stored in the communications terminal (column 6, line 35-column 8, line 54; column 40, lines 53-67; column 46, lines 10-61), automatically contacting, by the communications terminal the center at the stored time (column 58, lines 1-column 59, line 48), transmitting a media object assigned to the object identification by the center via a radio network to the communications terminal where it is stored in a memory and playing back, by a media playback module of the communications terminal, a media content contained in the stored media object (figures 1A-D; columns 6-8; figures 12, 13 and associated text). Downs does not

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explicitly disclose transmission of media objects at a time for optimal usage of resources. Zhao, however, teaches an efficient optimal resource usage technique that exploits both temporal and smoothing spatial multiplexing for optimal usage of resources during transmission of media objects (pp.13-14, 16-17, 20-22). It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Downs' media transmission technique and combine Zhao's optimal data multiplexing technique in order to provide content during optimal transmission times to accommodate the growing use of bandwidth for transmission of media objects and prevent bottlenecks and promote efficiency of data transfer, as per teaching of Zhao.

As per claim 2, Downs further discloses the method of claim 1, wherein prior to transmission to the communications terminal, the media content of the media object is encrypted with a first key, assigned to said media object, and the media content is decrypted by said first key prior to playback through the media playback module (figures 3-4 and associated text).

As per claim 3, Downs further discloses the method of claim 2 wherein media objects stored in a first said communication terminal are selected by the user of said first communications terminal and are transmitted to a second communications terminal, the media content of these media objects remaining encrypted (figure 1D and associated text; col. 12-14).

As per claim 4, Downs further discloses the method of claim 2, wherein the first key assigned to the media object, is transmitted encrypted, encrypted by a public second key, to the respective communications terminal and is decrypted in the respective communications terminal

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by a private third key, the pair of keys, of the public second key and the private third key, being assigned to the user of the respective communications terminal (figure 6 and associated text; col. 37-39, 44-46).

As per claim 5, Downs further discloses the method of claim 4, wherein data about conditions of use for the media object are also sent to the communications terminal separately or together with the first key assigned to this media object (figure 6 and associated text).

As per claim 6, Downs further discloses the method of claim 4, wherein for decryption of the media content of the media object, the decrypted first key assigned to this media object is transmitted in a protected way to a decryption module of the communications terminal (columns 12-14).

As per claim 7, Downs further discloses the method of claim 1, wherein the media objects include in each case indications about the center where the respective media object can be obtained (figure 1B and associated text).

As per claim 8, Downs further discloses the method of claim 2, wherein the media objects include in each case indications about a key server from which the encrypted first key can be obtained (figures 2-5 and associated text).

As per claim 9, Downs further discloses the method of claim 8, wherein a key obtaining module of the respective communications terminal automatically requests, receives and stores the encrypted first key in each case from the key server (figure 12 and associated text).

As per claim 10, Downs further discloses the method of claims 1 to 9, wherein the media objects include in each case indications concerning the media content of the media object, for example price information, title indications, playing duration or a sample playback (columns 48-49).

As per claim 11, Downs further discloses the method of claims 1 to 10, wherein as payment for the playback of the media content of the media object a monetary amount assigned to this media object is debited against a prepaid monetary amount stored on a chip card of the respective communications terminal (columns 75-76).

As per claim 12, Downs further discloses the method of claims 1 to 11, wherein the number of playbacks of said media content of the media object is counted in the respective communication terminal and this number is transmitted to a license server (columns 59-60).

Claims 13-22 are directed to a device or terminal of the above claimed method and are therefore rejected on the same grounds (see above).

(10) Response to Argument

A. Independent Claims 1 and 13

In response to Appellant's argument that the Examiner did not provide a separate statement of rejection for claim 13 and therefore Appellant was given no opportunity to comment is unfounded (Appellant's brief pp. 4-5). In fact, claim 13 is directed to mobile terminal configured to carry out the steps of claim 1 and therefore reliance on the rejection of claim 1 was proper.

Appellant's argument that the Examiner has not considered certain words in the claims is untrue (brief p. 5). Transmission by a mobile communications terminal over a mobile radio network to a center is common to the cited references and therefore generic to the claims. Downs discloses utilizing the invention via any communication network via telephone or cable connection and Zhao includes use via PCs, TV set-top boxes and wireless hand-held devices (see field of invention and introductory comments in Zhao).

In fact, Appellant had ample opportunity during the prosecution to argue before the Examiner with regards to the cited references, however, Appellant failed to do so (see response dated 1/20/2006). Appellant's contention that the Examiner failed to consider the claim language and that the references fail to teach a mobile communication terminal is presented for the first time in this brief (Applicant had at least two prior opportunities prior to the filing of the Appeal).

In response to Appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art (brief pp. 11-12). See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, in Downs, the workflow manager recognizes the need for automated processing based on customized rules and variables, i.e., time. In Zhao, an efficient optimal resource usage technique exploits both temporal and smoothing spatial multiplexing for optimal usage of resources during transmission of media (pp. 13-14, 16-17 and 20-22).

Appellant contends that Zhao does not teach transmitting data on a time determined by the center with regard to optimal usage of resources used for transmission of ordered media objects (brief p. 13-14). Appellant indicates that in Zhao the server determines time of delivery whereas in applicant's invention the "center" determines to transmit at an optimal time. Thereafter, Appellant argues that in Zhao the "time of initiating streaming is intended to start immediately after the request" and therefore fails to teach the claimed subject matter. The examiner respectfully disagrees. The main feature of the Zhao reference is mechanisms for scheduling a time of transfer of media objects in order optimize efficient bandwidth usage (see pp. 13-14). If in fact media objects were sent immediately, Zhao would not accomplish usage

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resource optimization. In fact, the scheduler, as pointed out by Appellant accomplishes such a task. Furthermore, Appellant's distinction between a center and the server does not distinguish the claimed invention from the references at hand.

In response to the argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., invention is not intended for streaming media) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Examiner notes that the language of the claim does not make such a distinction.

Appellant argues that Zhao teaches away from the claimed invention since it describes bandwidth-efficient continuous media streaming rather than a downloading and playing back scenario (brief pp. 12-14). It is noted that the features upon which applicant relies are not recited in the rejected claim(s). Appellant's claim merely recites that "**the media object is stored in a memory**" rather than the memory of the requesting device as argued (emphasis added). Therefore, the memory relied upon could be in the memory of the server, as in Figure 2 of Zhao. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In fact, contrary to Appellant's argument that Zhao fails to teach playback of the media, Zhao provides the proof wherein the first playback starvation occurred at a time $t(j)$ when a media element from a stream with deadline had not been delivered by the time $t(j)$ (Zhao p. 18).

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

B. Dependent Claims 2-12 and 14-22

Since Appellant relies on the arguments of the independent claims to overcome the rejection, the Examiner relies upon the above noted arguments to sustain the rejection.

(11) Related Proceeding(s) Appendix

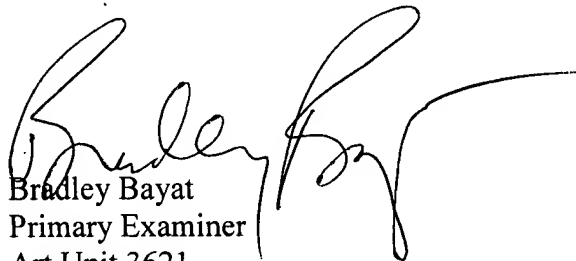
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Claim 1: A method for ordering and transmitting of digital objects comprising:	Downs, et al. 6,226,618 B1 Electronic Content Delivery System	Zhao et al. Bandwidth-Efficient Continuous Media Streaming Through Optimal Multiplexing
transmitting an object order for digital media objects that comprises at least one object identification by a mobile communications terminal over a mobile radio network to the center	Figure 1b, 1d, 2 and associated text	
transmitting data on a time at which an ordered media object is available by the center to any communications terminal, wherein the time is determined by the center and is stored in the communications terminal	Column 10, lines 15-19, timed-availability restrictions; column 6, line 35-column 8, line 54; column 40, lines 53-67; column 46, lines 10-61	
automatically contacting, by the communications terminal the center at the time	Automatic acquisition and availability; column 58, lines 1-column 59, line 60	
transmitting a media object assigned to the object identification by the center via a radio network to the communications terminal where the media object is stored in a memory and playing back, by a media playback module of the communications terminal, a media content contained in the stored media object	Table on column 19; column 11, line 55-column 12, line 6 [transmission infrastructures designed for bandwidth adaptability via modules]	
Time of transmission of media objects is determined by the center with regards to optimal usage of resources used for transmission of media objects	Motivation: [work flow manager recognizes the need for automated processing based on customized rules and variables, i.e. time]	An efficient optimal resource usage technique that exploits both temporal and smoothing spatial multiplexing for optimal usage of resources during transmission of media objects (pp.13-14, 16-17, 20-22)

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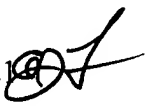
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Bradley Bayat
Primary Examiner
Art Unit 3621

Conferees:

Andrew Fischer, SPE 3621



Vincent Millin, Technology Center 3600 Appeals Specialist

